BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 26 ³⁵

Application Number: 08/935,116
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Appellants: David W. Deaton et al.

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GROUP 3600

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For Appellant

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EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed February 4, 2002.

(1)   ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

(2)   ***Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect
or be directly affected by or have a bearing on the decision in the pending appeal is contained

in the brief.

(3) ***Status of Claims***

The statement of the status of the claims contained in the brief is correct.

(4) ***Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) ***Summary of Invention***

The summary of invention contained in the brief is correct.

(6) ***Issues***

The appellant's statement of the issues in the brief is correct.

(7) ***Grouping of Claims***

The rejection of claims 8-39 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together *and reasons in support thereof* (emphasis added). For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of 37 CFR 1.192, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable. Each ground of rejection contains two or more independent claims. Appellant has stated that the claims do not stand or fall together, but has not stated reasons in support thereof per 37 CFR 1.192(c)(7).

2

Under paragraph (c)(8), appellant has not explained why each of the two or more claims are believed to be separately patentable. The explanation discussed patentability of the claims over the prior art but not the separate patentability for each of the two or more claims. Because no statement explains why each of the two or more claims are believed to be separately patentable, each ground of rejection should stand or fall for the claims in each group.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,109,238	Creekmore	8/1978
Re.30,580	Goldman et al.	4/1981
4,9087,61	Tai	3/1990
4,910,672	Off et al.	3/1990
5,010,485	Bigari	4/1991
5,201,010	Deaton et al.	4/1993
5,305,196	Deaton et al.	4/1994
5,592,560	Deaton et al.	1/1997
5,659,469	Deaton et al.	8/1997

Claim Rejections - 35 USC § 101

Claims 33-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The independently claimed invention recites stored transaction data which does not produce a useful, concrete or tangible result under *In re Alappat,* 31 USPQ2d 1545, 1558 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v Signature Financial Group. Inc.,* 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). The recited stored transaction data does not perform a function which would result in a useful, concrete, or tangible result such that the inventor may be entitled to a patent. The claimed data is considered non-functional descriptive material under MPEP 2106. Examiner bases further art rejections on the assumption that the claims are statutorily permitted.

Claim Rejections - 35 USC § 102

Claims 8, 9, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Creekmore (4,109,238). Creekmore discloses a system comprising:

a terminal **13** for entering unique customer identification codes from customer identification presented at the point-of-sale in a retail transaction;

means **26** & **27** for allowing entry of customer transaction data (the disclosed slot **26** and side **27** of the input terminal allows entry of customer transaction data because a customer enters an identification card transaction data **25**);

a processor **19** and a memory **20** responsive to said terminal and said means allowing

2

entry for creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code; and

circuitry **18** & **25** responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale during said individual customer's transaction at said retail establishment upon detection of a unique identification code of said individual customer, said signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit, and said signal providing information at said point-of-sale terminal derived from said database and useful for effectuating targeted customer promotion. Creekmore inherently generates a customer information response signal as a function of analysis by circuitry of the individual customer's transaction following the detection of said unique identification code of the individual customer since the teachings of Creekmore disclose customer recognition and analysis.

Claims 33-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldman et al. (Re 30,580). Goldman et al. discloses a customer database comprising: stored transaction data from prior point-of-sale transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with an identification of that customer, said transaction data including dollar amount of purchases and time period or alternatively including total dollar amount of purchases purchased during a period of time associated with an identification of a customer. Please refer to column 5 of Goldman which shows a table that lists up to five stored transactions outputs displayed to a cashier who will inherently be at a

3

point of sale for a transaction (cashiers are normally at a point of sale during transactions).

Not only does the output store a plurality of individual customer's data but the dollar amount

(i.e. worthless, habitually overdrawn, or valid) and current time period. Goldman et al. also

discloses time period of a day of week (discussed in the first full paragraph of column 12) and

number and frequency of transactions (discussed at column 5).

Claim Rejections - 35 USC § 103

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Creekmore in view of Off et al. (4,910,672). Creekmore discloses a method comprising:

entering into a point-of-sale terminal a unique identification code for a customer (please

see column 3 lines 6-10 which teaches the equivalent entry of account information and personal

code into a transaction processor as the claimed point-of-sale terminal customer unique

identification code);

entering into said terminal transaction data relating to the customer's

shopping transaction (please see column 3 lines 19-45 which teaches the equivalent transaction

processor **19** that performs the claimed terminal transaction data entry);

generating and maintaining a database, including the step of correlating said transaction

data with said unique identification code (please see column 3 lines 39-66 which teach the

equivalent generating and maintaining steps throughout the check cashing master file **20**).

Creekmore discloses the claimed invention except for the step of:

responding to entry, during a current transaction, of said unique identification code for

a customer by analyzing said transaction data of the customer, including data in said database

4

from prior transactions, with or without data from the current transaction, in order to generate a response which is a function of said data in said database from prior transactions, and by supplying said response to said terminal during said current transaction in which said unique identification code is entered, said response including information for effecting a targeted promotion to the customer. Off et al. discloses that it is known to provide the step of responding to entry, during a current transaction, of said unique identification code for a customer by analyzing said transaction data of the customer, including data in said database from prior transactions, with or without data from the current transaction, in order to generate a response which is a function of said data in said database from prior transactions, and by supplying said response to said terminal during said current transaction in which said unique identification code is entered, said response including information for effecting a targeted promotion to the customer, as set forth at column 9, lines 15-60 (the input data at a scanner including a keyboard generates a coupon which inherently performs the claimed step of responding to entry in the same manner with the same function with the same results). It would have been obvious to one skilled in the art, at the time the invention was made to modify the teachings of Creekmore, by providing the step of responding to entry, during a current transaction, of said unique identification code for a customer by analyzing said transaction data of the customer, including data in said database from prior transactions, with or without data from the current transaction, in order to generate a response which is a function of said data in said database from prior transactions, and by supplying said response to said terminal during said current transaction in which said unique identification code is entered, said response including information for effecting a targeted promotion to the

customer, as taught by Off et al. in order to allow a more effective marketing scheme to

reward frequent shoppers with targeted promotions.

Claims 10, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Creekmore in view of Off et al. in further view of Tai (4,908,761). Creekmore in view of Off

et al. discloses the claimed invention, as discussed above, except for the response being related

to the individual customer's transaction data in shopping visits prior to the current shopping

visit. Tai discloses that it is known to provide the response being related to the individual

customer's transaction data in shopping visits prior to the current shopping visit, as set forth at

column 3, lines 18-50. It would have been an obvious to one skilled in the art, at the time the

invention was made to modify the teachings of Creekmore in view of Off et al., by providing

the response being related to the individual customer's transaction data in shopping visits prior

to the current shopping visit, as taught by Tai in order to allow effective present time

marketing by offering shoppers instantaneous promotional offers while actively shopping.

Claims 17-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Creekmore in view of Off et al. in view of Tai in further view of Bigari. Creekmore in view

of Off et al. in view of Tai discloses the claimed invention except for the dollar amount and

time of purchase. Bigari discloses that it is known to provide a step of manipulating the dollar

amount and time of purchase, as set forth at column 8, beginning with line 39. It would have

been obvious to one skilled in the art, at the time the invention was made to modify the

teachings of Creekmore in view of Off et al. in view of Tai, by providing a step of

manipulating the dollar amount and time of purchase, as taught by Bigari in order to more effectively target consumers while shopping for promotional offers designed by marketing agencies.

Double Patenting

Claims 8, 9, 12, and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 23 of U.S. Patent No. 5,305,196. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would be obvious to add a terminal for a check transaction processing, database building and marketing method and system utilizing automatic check reading.

Claims 10, 11, and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18 and 26 of U.S. Patent No. 5,201,010 in view of Tai. It would have been obvious to one skilled in the art to add the feature of a response being related to the individual customer's transaction data in shopping visits prior to the current shopping visit in order to allow effective present time marketing by offering shoppers instantaneous promotional offers while actively shopping.

Claims 17-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of U.S. Patent No. 5,592,560. Although the conflicting claims are not identical, they are not patentably distinct from each

other because it would have been obvious to one skilled in the art to claim broader subject matter than what is claimed in Appellants' issued patent for an extension of patent rights.

(11) *Response to Argument*

anticipatory rejection of claims 8, 9, 12, & 13

Appellants argue that Creekmore's terminal is not at the point of sale as independently claimed. However at column 5, beginning at line 18, Creekmore discusses "terminal 13 which may be positioned at any convenient point-of-use location such as a location near the checkout." Examiner interprets the prior art recitation of a "terminal at any convenient point-of-use location" to be equivalent to Appellants' claim recitation "a terminal at the point-of-sale." The point-of-use is equivalent to the point-of-sale because Creekmore uses the example of a customer check being processed at a checkout lane of a grocery store. Appellants argue that the example taught be Creekmore does not encompass Appellants' claim language. Examiner reads "at any point-of-use location" to expressly anticipate "a terminal at the point-of-sale."

Appellants further ague that Creekmore does not allow entry of customer transaction data as claimed. At column 5 and 6 of Creekmore, customer data entry including inserting an identification card 25 into the terminal and a customer identification card 15 for "transaction information received at the input terminal" is discussed at column 6 lines 10-11. Appellants assert that the "only information entered by the customer in Creekmore's system is the customer' account number and identification code." This asserted "information entry" is

8

expressly processed by a transaction processor **19** such that the claimed recitation of "allowing entry of customer transaction data" is anticipated by Creekmore. Appellants state that the examiner is incorrect because a distinction is not made between the terminal for entering unique customer identification codes for customer identification and means for allowing entry of customer transaction data. A distinction need not be made because, beginning at the first full paragraph of column 6, "input terminal **13** transmits customer-entered information, as well as machine-readable information obtained from the identification card **15**, to the transaction processor **19**." Examiner interprets this recitation, as read in the context of Creekmore, to anticipate Appellants first two clauses (a terminal for entering and means for allowing) of claim 8.

Because no statement explains why each of two or more claims are believed to be separately patentable, the Creekmore ground of rejection should stand or fall for claims 8, 9, 12, and 13.

anticipatory rejection of claims 33-39

Appellants argue that there is no disclosure in prior art reference Goldman et al. of a computer implemented customer database comprising stored transaction data wherein the transaction data includes dollar amount of purchases and time period. The table at column 5 of Goldman et al. shows consumer purchaser status based on cashing checks. Customers are identified based on their check cashing history. A worthless check has a zero dollar amount which implicitly anticipates Appellants claimed transaction data including dollar amount. It is also implied at column 1, that merchants will cash checks after requesting a form of

identification. The check cashing implicitly will carry a dollar amount since customers use checks for merchant purchases based on a dollar amount of goods and/or services. The same table at column 5 discloses the number of checks cashed during a current period. This current period disclosure anticipates Appellants claimed transaction data including time period. Likewise, the total dollar amount of purchases purchased, purchases per week, number of transactions, frequency of transactions, frequency in a specified time, and where the time period for frequency is one week is anticipated by the transaction data disclosed at the table in column 5, for the reasons discussed with respect to the dollar amount and time period transaction data.

Because no statement explains why each of two or more claims are believed to be separately patentable, the Goldman et al. ground of rejection should stand or fall for claims 33-39.

obviousness rejection of claims 15 & 16

Appellants argue a lack of motivation for combining the teachings of Creekmore with Off et al. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

10

applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The teaching of Creekmore incorporates the claimed features of correlating terminal transaction data with customer identification in a shopping transaction as discussed in the rejection above. In the same field of endeavor, Off et al. provides the missing independently claimed element for transaction analyzation for response generation. Examiner considers the reconstruction of Creekmore and Off et al. to be proper in order conclude obviousness, based on one of ordinary skill at the time the invention was made.

Both the Creekmore and Off et al. references involve customer purchasing at retail establishments such that one of ordinary skill in the art would use the effective marketing scheme implied by Appellants to reward frequent shoppers with targeted promotions. This reward feature is obviated by those references because examiner considers customer purchasing at retail establishments to logically be in the same field of endeavor. Prior art references in the same field of endeavor are normally combinable to those skilled in the art.

Appellants further argue that the combination of the prior art would not result in the independently claimed subject matter. As discussed in the anticipatory rejection of claims 8, 9, 12, & 13 paragraphs above, examiner considers that Creekmore discloses a unique identification code for a customer at a point-of-sale terminal. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do

11

so found either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and

In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the claimed data

analyzation for coupon distribution is disclosed in Off et al. for the motivation discussed under

that reference's summary of the invention, specifically where conditioned coupon printing and

coupon triggering is discussed.

In response to Appellants' arguments against the references individually, one cannot

show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In*

re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellants also argue that Off et al. does not include the use of a unique identification

code for a customer. Examiner disagrees. The disclosed response return point with respect to

file access requests, disclosed at columns 9 & 10, inherently meets the independently claimed

unique identification code for each shopper because each shopper's transaction is unique as

reported at the disclosed response return point. Examiner considers the independently claimed

use of a unique identification code for a customer to be equivalent to the disclosed response

return point taught in the prior art.

Examiner acknowledges that Appellants consider the above rejection and response to be

clearly incorrect. Examiner submits that the primary references be read as a whole rather than

attacking the parts of each teaching.

Because no statement explains why each of two or more claims are believed to be

separately patentable, the Creekmore in view of Off et al. ground of rejection should stand or

12

fall for claims 15 and 16.

Claims 10, 11, or 14 generally recite the steps of entering customer data, including identification and transaction information, at a point-of-sale of a retail establishment and creating a database from transactions of prior retail establishments visits. Claims 15 or 16 generally recite the steps of entering customer data, including identification and transaction information, at a point-of-sale of a retail establishment and generating and maintaining a database from transactions which correlate transaction information and identification data. Examiner considers the claim 10, 11, or 14 general recitation "creating a database from transactions of prior retail establishments visits" to be equivalent to the claim 15 or 16 recitation "generating and maintaining a database from transactions which correlate transaction information and identification data" because "create" or "generate and maintain" a database of transactions. The claimed "creating" and "generating and maintaining are functionally equivalent. Since both claimed elements are equivalent, the Creekmore in view of Off et al. references that were used to reject claims 15 and 16 can be used to reject claims 10, 11, and 14. Appellants argue that Creekmore in view of Off et al. does not teach either (1) the step of creating a database or (2) the step of generating a customer information response as recited in claims 10 and 11. The step of creating a database is taught in Creekmore at column 3 lines 39-66 as discussed above in the rejection of claims 15 and 16 under 35 USC 103 and addressed in the examiner's response to the arguments concerning the obviousness rejection of claims 15 and 16 above. The step of generating a customer information response

13

is taught in Off et al. at column 9, lines 15-60 as discussed above in the rejection of claims 15 and 16 under 35 USC 103 and addressed in the examiner's response to the arguments concerning the obviousness rejection of claims 15 and 16 above. Tai is not needed to the deficiencies argued by Appellants. Creekmore in view of Off et al. teaches the equivalent matter claimed in claims 10, 11, and 14 as claimed in claims 15 and 16. The Tai reference was used to teach that it is known to provide the response being related to the individual customer's transaction data in shopping visits prior to the current shopping visit.

Appellants disagree that Off et al. teaches the equivalent response return point with respect to file access requests, to the claimed unique identification code for each shopper. Each shopper's transaction is unique as reported at the disclosed response return point. Each transaction is unique because each shopper is identified. The claimed unique identification code for each shopper is implicit to the teaching of a response return point in Off et al.

Appellants also argue Tai fails make up the deficiencies of Creekmore and Off et al. with respect to the subject matter of any one of claims 10, 11, or 14 because it is alleged that Tai has nothing to do with shopping visits prior to the current shopping visit. Tai teaches at column 3:

> It is a further object of the present invention to provide a system and methodology which tracks and measures the actual redemptions of coupons by these heaviest product purchasing and regular coupon using households so as to determine marketing information based on the consumer promotional behavior response patterns of these consumers and thus determine with a high degree of accuracy predictable consumer promotional behavior and response patterns.
> The delivery of the coupons to the selected consumer households would also include at least one and preferably a plurality of consumer activated encoding devices each of which being designed to be attached to a coupon. The at lest one consumer activated encoding device

delivered to each consumer includes the name and address of the receiving consumer in machine readable language. Those purchase incentive offers having the attached encoding devices are received for redemption like other coupons, however the names and addresses of the consumers submitting the encoded coupons received for redemption are read and recorded and a refined list of consumer names and address that actually redeem coupons is created from the initial prepared list of consumer names and addresses that actually redeem coupons is created from the initial prepared list of consumers.

By including machine readable data relative to the product, such as size, price, etc., on every delivered coupon and by periodically delivering additional purchase incentive offers and consumer activated encoding devices to the refined list of consumer names and addresses and analyzing the redemption characteristics of the various purchase incentive offers, consumer promotional behavior response patters of heavy shopping households can be determined and thus consumer promotional behavior response patters can be predict with a high degree of accuracy.

It is implied that heavy product purchasing of regular coupon using households, along with encoding and refinement, shoppers redeem coupons at shopping visits prior to the current shopping visit as taught by Tai. The "heaviest product purchasing," "regular coupon using households," and "consumer activated encoding devices to the refined list of consumer names and addresses and analyzing the redemption characteristics of the various purchase incentive offers" teaches that Appellants allegation is contrary to the implicit teachings of Tai when viewed with Creekmore in view of Off et al. Refining the consumer list and analyzing the redemption characteristics imply that Tai teaches Appellants' claimed response signal being related to the individual customer's transaction data in shopping visits prior to the current shopping visit because refinement and analyzing involves relating customer's current shopping visit to a prior shopping visit. All three references expressly or implicitly teach shopper interaction with retail establishment.

15

Contrary to Appellants' statement that the "prospective customer many never have been in the store before presenting the coupon received in the mail, and he or she my never have been in the store before presenting the coupon received in the mail, and he or she may never come back again," that point is <u>not</u> clear from the disclosure of Tai at column 3 lines 36-50 (generally copied above).

Because no statement explains why each of two or more claims are believed to be separately patentable, the Creekmore in view of Off et al. in further view of Tai ground of rejection should stand or fall for claims 10, 11, and 14.

obviousness rejection of claims 17-32

Appellants argue that Creekmore, Off et al., or Tai does not teach or suggest (1) the structure recited in claim 17 of a computer implemented system providing a signal at a point-of-sale depending upon a customer[']s shopping history and comprising a terminal for entering, during a transaction, a unique customer identification or (2) a database storing transaction data from prior transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with an identification of that customer. Examiner does not suggest that those references singly teach the claimed invention, it is the combination of Creekmore in view of Off et al. in further view of Tai that teaches that part of the claimed invention. Part of the body of claims 17-32 generally recite the steps of a terminal for entering customer data, including identification and transaction information, a database for storing transactions of prior shopping visits, and transmitting a customer information response signal to a point-of sale. Claims 10, 11, or 14 generally recite the steps of entering customer data,

16

including identification and transaction information, a database for storing transactions of prior

shopping visits, and generating a customer information response signal to a point-of sale.

Examiner considers the any one of claims 17-32 general recitation "entering customer data,

including identification and transaction information, and transmitting a customer information

response signal to a point-of sale" to be equivalent to the claim 10, 11, or 14 recitation

"entering customer data, including identification and transaction information, generating a

database from transactions which correlate transaction information and identification data"

because "generating" or "transmitting" are functionally equivalent. Since both claimed

elements are equivalent, the Creekmore in view of Off et al. in further view of Tai teaching

that were used to reject claims 10, 11, and 14 can be used to reject claims any one of

claims 17-32. The rejection used for claims 10, 11, and 14 can be applied to the recited steps

of any one of claims 17-32. The step of entering customer data, including identification and

transaction information or creating a database is taught in Creekmore at column 3 lines 39-66

as discussed above in the rejection of claims 10, 11, and 14 under 35 USC 103 and addressed

in the examiner's response to the arguments concerning the obviousness rejection of claims

10, 11, and 14 above. The step of generating a customer information response is taught in Off

et al. at column 9, lines 15-60 as discussed above in the rejection of claims 10, 11, and 14

under 35 USC 103 and addressed in the examiner's response to the arguments concerning the

obviousness rejection of claims 10, 11, and 14 above. Tai Appellants argue that Creekmore in

view of Off et al. in view of Tai do not teach

Appellants argue that Creekmore in view of Off et al. in view of Tai in further view of

Bigari do not teach or suggest (1) the structure of a computer implemented system providing a

signal at a point of sale depending upon a customer[']s shopping history and comprising a terminal for entering, during a transaction, a unique customer identification or (2) a database storing transaction data from prior transactions for a plurality of customers, such that data regrading a customer's prior transactions are stored in association with an identification of that customer. Examiner disagrees. Each of the key elements claimed in Appellants' claims 10, 11, 14, 15, and 16 are essentially the same key elements as those recited in claims 17-32. Examiner considers the method claims 10, 11, 14, 15, and 16 to be coextensive and not patentably distinct from apparatus (method) claims 17-32. Since both sets of claims are coextensive, the same prior art can be used to obviate the method steps as well as the apparatus features. Examiner considers Creekmore in view of Off et al. in view of Tai in further view of Bigari to obviate the claimed invention as discussed above under obviousness rejection of claims 10, 11, & 14 and the rejection above. Examiner does not concede the patentability of claims 15 and 16 necessitates the patentability of claims 10, 11, 14 and 17-32, because each rejection is separately applied to each group of claims.

Appellants argue that claim 22 parallels claim 17 and that the rejection used for claim 17 should not be used for claim 22. For the reasons in the previous paragraph, examiner considers claim 22 should stand or fall with claim 17.

Appellants further argue that Bigari fails to disclose the step of manipulating dollar amount and time of purchase, but that is not what is claimed. Appellants independently claim the feature:

> wherein said customer information response signal depends upon
> data stored in said database indicating dollar amount of at least
> one prior purchase associated with said unique customer
> identification, or alternatively

18

updating transaction data and a dollar amount of purchases associated with said unique customer identification in said customer database in response (with or without circuitry) to entry of said unique customer identification and said transaction data at said terminal.

At column 8 Bigari teaches

[M]icroprocessor **12** stores the maximum charge amount at **76** with this amount being correlated to the transaction identification data stored at **48**, each of which is stored in memory **26**. In addition, microprocessor **12** commands voucher printer **30** to generate the voucher according to the approved transaction with voucher printer **30** preferably producing duplicate printed credit receipts A, B, at **78**. The customer may sign receipts A and B as shown at **80**, when this occurs, the voucher becomes valid for a purchase amount up to the maximum charge among which is shown thereon. To this end, it is preferred that both receipts A, B which comprise the voucher include both account identification data as well as the maximum charge amount permitted. Further, the voucher may be printed or indexed with an expiration date after which it ceases to be valid.

Referring to FIG. **3**, a flow chart diagram is provided of the continuation of the purchased transaction of the customer at a point of purchase station which may be preferably be a cash register or the like. As is shown in FIG. **3**, the point of purchase transaction occurs at **100** wherein a customer selects the goods and/or services to be purchased and initiates that purchase at **102**. This amount is automatically calculated or is entered into the point of purchase accumulator, which may be conveniently referred to as a cash register. A decision is made either by the operator of the cash register or automatically, as described below, of whether the purchase amount is greater than the approved maximum charge amount. This determination is made at **104**. If the purchase amount exceeds the maximum charge amount, a new purchase amount must be initiated at **102** until such time that the purchase amount is less than or equal to the maximum charge amount. When this occurs, the purchase is executed at **106** and the voucher is updated, as is shown at **108**, to reflect the actual purchase amount, and the purchase is finalized at **110**. The customer then receives the updated receipt B as shown at **112**, while the merchant retains updated receipt A, as is shown at **114**.

Examiner considers Appellants recited feature to be disclosed in the quoted portion of the Bigari reference. Bigari teaches a customer purchase processor using stored transaction information for sending a response signal or updating transaction data based on charge card purchases (please see the abstract). The claimed "customer response signal" is expressly taught by Bigari because a purchaser must satisfy stored transaction data to complete a purchase by using a dollar amount based on the maximum charge amount permitted. This maximum charge permitted correlates to prior purchases (or the credit limit on the charge card) which directly correlates to the claimed "customer response signal" because the charge permitted is based on a response signal from the purchaser or customer. The claimed "updating transaction data" is also expressly taught by Bigari, because the stored maximum charge amount based on transaction data and dollar amount of unique customer identified purchases is calculated or entered into a point of purchase accumulator. This point of purchase accumulator allows a decision determination based on updated transaction data. Appellants claimed features are both expressly taught by the Bigari reference.

Examiner submits the dependently claimed features: dollar amount of a plurality of purchases, the frequency of prior purchases, the transaction frequency and dollar amount, the transaction date, the transaction date and dollar amount, and the date are all implicitly taught by Bigari because the disclosed customer voucher updating uses each of these claimed features to allow receipt/retention of the finalized purchase transaction.

Because no statement explains why each of two or more claims are believed to be separately patentable, the Creekmore in view of Off et al. in view of Tai in further view of Bigari ground of rejection should stand or fall for claims 17-32.

20

non-statutory subject matter rejection of claims 33-39

Appellants have not argued that the amended claims clearly recite a useful, concrete, and tangible result. Claims 33-39 merely recite data without a machine or process manipulating the data. A machine or process manipulating the data would entitle Appellants to a patent which would result in a useful, concrete, and tangible result. Appellants assertion that a computer implemented customer database provides a useful, concrete, and tangible result does not recited a machine or process manipulating the data which would entitle Appellants to a patent.

Because no statement explains why each of two or more claims are believed to be separately patentable, the non-statutory subject matter ground of rejection should stand or fall for claims 33-39.

double patenting rejection of claims 8, 9, 12, & 13

Appellants argue that Appellants' earlier patent does not include means or a terminal for entering customer transaction data at the point of sale in the retail establishment and does not have (1) a processor and a memory responsive to the apparatus for entering unique identification codes or (2) the terminal for entering customer transaction data for creating a database of a plurality of the retail establishment's customers' transaction data from prior shopping visits nor does it have circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point of sale during the individual customer's transaction. Examiner looks to the features recited in the present application and

21

compares those features to Appellants' earlier patent. The first claimed feature, "a terminal for entering unique customer identification codes from customer identification presented at the point of sale in a retail transaction" is an obvious variation to the patented "device for entering a customer's unique identification customer identification code into said memory each time the customer makes a purchase at the store." The application claimed "terminal" meets the patented claim "device" limitation. The application claimed "point of sale" meets the patented claim "each time the customer makes a purchase at the store" limitation because purchases at stores are normally made at a point of sale. The application claimed "unique customer identification codes" is equivalent to the patented claim "customer's unique customer identification code" limitation. The second claimed feature, "means for allowing entry of customer transaction data" is equivalent to the patented claim "a terminal for entering unique customer identification codes from customer identification presented at the point of sale in a retail transaction" because customer identification code are part of customer transaction data in both the application and the patent. The third claimed feature, "a processor and a memory responsive to said terminal and said means allowing entry for creating a database for a plurality of the store's customers' transaction data from prior shopping visits, such that data regarding individual customer's prior transactions are stored in association with said individual customer's unique identification code" is equivalent to the patented claim "memory for storing a database of existing customers of the retail store, said database including each customer's checking account identification number for use as a unique customer identification code; and circuitry for comparing each entered unique customer identification code with the stored database in said memory, such that an up to date list of the store's customers is maintained."

22

The application claimed "transaction data from prior shopping visits" is implied from the patented claim "database including customer's checking account identification" because checking account identification is used for transaction data. Finally the fourth claimed feature, "circuitry responsive to said processor, memory, and database for generating a customer information response signal at the point-of-sale during said individual customer's transaction at said retail establishment upon detection of a unique identification code of said individual customer, said signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit, and said signal providing information at said point-of-sale terminal derived from said database and useful for effectuating targeted customer promotion" is an obvious variation to the patented claim "circuitry for comparing each entered unique customer identification code with the stored database in said memory, such that an up to date list of the store's customers is maintained, circuitry for comparing said stored database of existing customers with the stored list of prospective customers, and circuitry for eliminating all data from said list of prospective customers for use in marketing." The function of both circuitry claimed features is marketing. It is an obvious variation to one skilled in the art to use the circuitry in both claims for use in marketing. Examiner has compared each element of the independently claimed application invention with each element to the independently claimed patent to show that the present application is an obvious variation to Appellants earlier patent.

Because no statement explains why each of two or more claims are believed to be separately patentable, the double patenting ground of rejection should stand or fall for claims 8, 9, 12, and 13.

Appellants argue that secondary reference Tai does not teach or suggest generating a customer information response being related to the individual customer's transaction data in shopping visits prior to the current shopping visit because it is alleged that Tai has nothing to do with shopping visits prior to the current shopping visit. Tai implicitly discloses at column 3 that the heavy product purchasing of regular coupon using households, along with encoding and refinement, customers may redeem coupons at shopping visits prior to the current shopping visit. The "heaviest product purchasing," "regular coupon using households," and "consumer activated encoding devices to the refined list of consumer names and addresses and analyzing the redemption characteristics of the various purchase incentive offers" teaches that Appellants allegation is contrary to the implicit teachings of Tai when viewed Appellants' patent. Refining the consumer list and analyzing the redemption characteristics imply that Tai teaches Appellants' claimed response signal being related to the individual customer's transaction data in shopping visits prior to the current shopping visit because refinement and analyzing involves relating customer's current shopping visit to a prior shopping visit.

double patenting rejection of claims 17-32

Appellants argue a functional difference between the terminal and circuitry of patented claim 1 and the terminal of application claim 17. Patented claim 1 recites "a terminal for entering selected indicia from identification presented by customers at a point-of-sale in order to generate a unique identification code for each customer," while application claim 17 recites "a terminal, for entering, during a transaction, a unique customer identification." Both

recitations perform the same function because a unique customer identification results from terminal data entry. Since claim 22 is a method analog of claim 17, it should also be rejected for the same reason. Patented claim 1 also recites "circuitry responsive to said processor and said database for dispensing a sales promotion at the point-of-sale during a customer's checkout to said customers who meet said predetermined infrequent product purchase history criteria, wherein said sales promotion is for a product previously infrequently purchased and is redeemable at a further visit such that said customers are given the incentive to return to the retail establishment to purchase said previously infrequently purchased product in a further transaction," while application claim also 17 recites "circuitry responsive to the entry of said unique customer identification at said terminal during said transaction for transmitting to said point-of-sale during said transaction a customer information response signal." Examiner considers both sets of functions equivalent since both terminals allow customer identification data entry and both circuities are responsive to unique customer identification data. The terminals are equivalent because patented claim 17 allows unique identification customer codes terminal entry while application claim 1 allows unique customer identification terminal entry. Because the terminals are equivalent, the functions of both terminals are the same. Similarly, the circuitry of claim 17 allows customer identification by responding to the customer's previous shopping history in relation to a present shopping visit while the circuitry of application claim 17 allows customer identification of a present shopping visit. Both identify a customer because under the patented claim, data from a customer's prior shopping history can not be compared to a present shopping visit unless the customer identification were entered. Inherently, both circuitry features are equivalent. Appellants further argue that the patented

claim recites a reader and processor that is not recited in the application claim. It would be an inherent function to use a reader and processor in the application claim because the specification supports a reader and processor to perform the claimed functions and applicant has not recited steps or features contrary to the specified a reader and processor. Under the doctrine of equivalents, the essential objective inquiry is: "Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?" Warner-Jenkinson Co. v. Hilton Davis Chemical Co., 41 USPQ2d 1865, 1875 (1997). In determining equivalence, "[a]n analysis of the role played by each element in the context of the specific patent claim will thus inform the inquiry as to whether a substitute element matches the function, way, and result of the claimed element, or whether the substitute plays a role substantially different from the claimed element." Using the objective Warner-Jenkinson Co. inquiry, examiner finds equivalent elements with respect to terminal function and the circuitry function. In summary, examiner considers patented claim 1 to encompass the subject matter contained in application claims 17-21. The terminal and circuitry of the patented claim is recited broadly enough to encompass the terminal and circuitry of the application claim. Examiner considers the subject matter of both claims equivalent and perform the same function as discussed above. Similarly, the method claim of application claim 22 is co-extensive to apparatus application claim 17 for the same reasons discussed, the apparatus claims 22-26 are also rejected under the judicially created doctrine of obviousness-type double patenting. Appellants further argue that application claims 27-32 are patentably distinct from patented claims 1 and 3 for similar reasons argued with respect to claims 17-26. Examiner disagrees. The structure and steps in the patented claims are expressly and inherently equivalent to the

application claims as discussed above. The patented claims are broad enough to encompass the subject matter presently claimed. Because the present claims have been patented by Appellants, examiner maintains the rejection under the judicially created doctrine of obviousness-type double patenting. Using Appellants' fastener argument, if a safety pin can perform the same function as a hook and loop VELCRO ® fastener, it is irrelevant that they may not be considered equivalent. In both claimed elements, the terminal and circuitry performs the same function, with an obvious variation means or method, with the same result.

Because no statement explains why each of two or more claims are believed to be separately patentable, the double patenting ground of rejection should stand or fall for claims 17-32 (including the argument with respect to claims 18 and 23, 19 and 24, 21 and 26, 29, 30 and 32).

Conclusion

Appellants include an appendix II of proposed find[ing]s of fact and proposed conclusions of law. Examiner has considered appendix II but believes that the findings of fact are assertions of Appellants position that have been presented in earlier arguments. For example, Appellants attack examiner's interpretation in that a reference "does not disclose" a feature that examiner considers taught in the prior art by that reference either singly or in combination with other references. Furthermore, no conclusions of law have been presented by Appellants, but rather conclusions of Appellants' contrary findings to the examiner's position with respect to the prior art. Examiner has thoroughly reviewed appendix II and believes it to be duplicative of arguments presented in the appeal brief earlier. These

cumulative arguments do not bolster Appellants' position and as such, examiner will not

address each point again. Examiner maintains the rejections of claims 8-39 as being

anticipated, obviated, double patenting rejected, and including non-statutory subject matter.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

STEPHEN GRAVINI

PRIMARY EXAMINER

CONFEREES:

ERIC STAMBER, SPE (INITIALS: _____)

DONALD CHAMPAGNE, EXAMINER (INITIALS _____)

smg
May 15, 2003

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